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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/661,222	09/13/2000	John K. Overton	10406/43	7777

757 7590 02/09/2005

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EXAMINER

THOMPSON, MARC D

ART UNIT PAPER NUMBER

2144

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/661,222

Applicant(s)

OVERTON ET AL

Examiner

Marc D. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 12-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 12-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20001030, 20001208, 20030428,
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This application has been reassigned to a new Examiner. See Conclusion section below, for new Examiner contact information.
2. The latest claim amendment, received 8/25/2004, has been entered into record.
3. Claims 1-9 and 12-23 are now pending.

#### ***Priority***

4. This application claims priority to provisional application 60/153,709, filed 9/14/1999.
5. The effective filing date for the subject matter defined in the pending claims in this application which has support in the parent provisional application is 9/14/1999.

#### ***Drawings***

6. The Examiner contends that the drawings submitted on 9/13/2000 are acceptable for examination proceedings.

#### ***Information Disclosure Statements***

7. It should be noted that the applicant has submitted an exorbitant amount of prior art on numerous PTO-1449's which on initial consideration appears to not all have relevancy or pertinence to the instant invention as claimed. The applicant is requested in response to this office action to point out which of these numerous prior art are pertinent or relevant to the patentability of the invention as claimed in this instant application. It should be noted that it would be advantageous to the Applicant to provide a concise explanation of why each of the prior art is being submitted and how it is understood to be relevant. "Concise explanations are helpful to the Office, particularly where documents are lengthy and complex and applicant is aware of a section that is highly relevant to patentability or where a large number of documents

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are submitted and applicant is aware that one or more are highly relevant to patentability.” (See MPEP 609 under subheading “A. CONTENT”).

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-4 and 17-18 are rejected under 35 U.S.C. 101 because the claimed invention the claimed invention is directed to non-statutory subject matter, being inoperative, therefore lacking patentable utility.

10. The claims recite a “wire transfer protocol” comprising a number of “message[s] formatted to transport” information on a network. The messages do not actually effect transfer of anything as currently recited in the claimed invention. A protocol being defined in this art as “rules determining the format and transmission of data” does not explicitly or inherently require the mandate for transmission of such data. The joining of the physical machinery and any/all associated state changes of this machinery with the methodology actually performed, which optionally uses this protocol format(s) to effect physical changes and events in the system as a whole is required for proper recitation of statutory subject matter in this art. See, MPEP § 2106. “Protocols”, per se, are accepted, predetermined, commonly understood and interpreted data structures dictating communication formats, and constitute non-statutory subject matter since no functionality is inherently associated with the protocol definition(s).

***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-23 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. Claim 1 recites the limitation "...the identity of an entity..." in Line 4 of the claim, and recites "...location of data associated with an entity..." in Lines 7-8 of the claim. Minimally, it is unclear whether these two entities are distinct or not. That is, it is unclear whether there are two entities recited in the claim which have corresponding information associated therewith, or whether the two recited entities are one and the same. Further, "the entity" is recited in Line 11 of the claim, lacking sufficient antecedent basis for this limitation in the claim.

14. Claim 1 recites "wherein the protocol supports a machine-independent relationship between the identification string and the location string" in the last Lines of the claim. There are no ascertainable metes and bounds to this limitation. The Examiner is at a total loss to discern what this limitation is attempting to describe, and further, the limitations set forth in dependent claims 2-4 also provide for "application", "organizationally" and "geographically" "independent" protocol definition, also fail to describe any definition of actual "independence". The bounds of what is attempting to be described by these limitations is vague and indefinite.

15. Claim 5 dictates a "redirection message" but fails to expressly recite what this message is, what function it has, how it operates, or the end result of its use. Minimally, while a client and a first server entity are recited, no second entity is recited to justify the use of the term "redirection". It is unclear, partially due to the breadth ("skeletal nature") of the claims, what is being described. Significant clarification and elaboration is required.

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16. Claim 12 also recites “an entity” multiple times (Line 4, Line 5, Line 8), in combination with the use of “the entity” (Line 9, Line 14, Line 15) in a similar fashion to the deficiencies noted with claim 1. Further, other “entities” are recited in the claim. Clarification of the claimed invention using specific terms with clear and unambiguous language is required according to 35 U.S.C. §112.

17. Claim 12 also exhibits limitations in such breadth that functionality appears to occur in a vacuum, without any associated machinery. For example, the first limitation recites “providing a location string and an identification string...” It is unclear what “provides” this, where it is “provided” to, and other general details to clearly and concisely describe the system. Again, there is a failure to particularly point out and distinctly claim the inventive concept in accordance with the statutes.

18. Various claims recites the use of “hashing” function(s) and tables which do not properly specify what values are present in the table(s), what function the hashing function(s) perform, any specific functionality of the function(s) or use of the table(s), or an end result of actually implementing the functions and tables. If a functional element is recited in the claims, it is prudent to state its function as well as any details required to understand the process executed to effect the function in order to comply with 35 U.S.C. §112.

19. Lastly, the claims allegedly recite a “wire line transfer protocol” as argued by Applicant. However, none of the claims provide the transfer of information beyond location and identification data. It is presumed this information actually recited effects setup of a session/connection with remote networking equipment, which results in information transfer between two (or more) terminals. It is unclear from the claims the bounds of what constitutes

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this “wire line transfer protocol” due to the failure of the claimed invention to recite sufficient details to discern the methodology attempting to be defined, and how any intended use set forth in the preamble(s) are actually performed/achieved. Significant clarification and narrowing of the claims is suggested to advance prosecution of this application. Presently, Examiner notes a basic framework of limitations in the claims without enough details to properly analyze the claims properly in scope with the specification.

20. All dependent claims inherit these deficiencies present in their respective parent claims.

***Claim Rejections - 35 USC § 102***

21. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

22. Claims 1-9 and 12-23 are rejected under 35 U.S.C. §102(b) as being anticipated by Beitz et al. (“Service location in an open distributed environment”, Second International Workshop on Services in Distributed and Networked Environments, ISBN 0818670924, June 1995), hereinafter referred to as Beitz.

23. The claims describe a client generated message which effects a redirection message which is sent to another server process when the initial server process cannot provide a “location

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string” in response to the client request. Simply, the invention resolves “identification string(s)” into “location string(s)” using a second server process in response to a “redirection” of an initial client request. Further details include hashing and the use of tables to correlate location information and identification information.

24. Beitz disclosed a request message for requesting “locators” to resolve names into access data for particular name server(s), which in turn resolve the request into returned access list(s) (See, *inter alia*, Section 2.3). This section also expressly provided multiple naming servers, and service locators providing “dynamic extensibility” using “interworking” of multiple naming servers. See, *inter alia*, Figure 3. These naming servers inherently implemented tables, with mapping hashing functions to lookup location/address/etc. information, as well as to effect direction of naming requests to other naming servers. See, *inter alia*, Section 2.3 and 3.2. The storage, retrieval, functional lookup, database maintaining, client/server interoperation of request/response, and current network addressing and naming conventions were all explicitly disclosed by Beitz. See, above cited sections, and Section 4.

25. Claims 1-9 and 12-23 are rejected.

26. Claims 1-9 and 12-23 are rejected under 35 U.S.C. §102(e) as being clearly anticipated by Perkowski (U.S. Patent Number 5,950,173), hereinafter referred to as Perkowski.

27. The claims describe a client generated message which effects a redirection message which is sent to another server process when the initial server process cannot provide a “location string” in response to the client request. Simply, the invention resolves “identification string(s)” into “location string(s)” using a second server process in response to a “redirection” of an initial



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client request. Further details include hashing and the use of tables to correlate location information and identification information.

28. Perkowski disclosed an information collection, transmission, and delivery system effecting universal product code (UPC) to universal resource locators (URL) correlation, translation, resolving, and data correlation effecting information storage, lookup and transfer. See, inter alia, Column 11, Line 34 through Column 12, Line 35. In this section, the provision for multiple servers acting to translate/resolve identification information into location information was also provided with the express provision for the use of mapping tables and inherent hashing algorithms for information access and retrieval from remote database(s). See, inter alia, Figures 2A1, 2A2, 4A1, 4A2, and 4B. Also, Figures 5A and 5B expressly provide a protocol providing redirection of information mapping request(s) to multiple servers implementing functionality as claimed identically. See, inter alia, Column 22, Line 24 through Column 23, Line 5. All remaining limitations are either expressly provided by Perkowski or inherent in the Perkowski system.

29. Claims 1-9 and 12-23 are rejected.

30. Claims 1-9 and 12-23 are rejected under 35 U.S.C. §102(e) as being anticipated by Hudetz et al. (U.S. Patent Number 5,978,773), hereinafter referred to as Hudetz.

31. The claims describe a client generated message which effects a redirection message which is sent to another server process when the initial server process cannot provide a "location string" in response to the client request. Simply, the invention resolves "identification string(s)" into "location string(s)" using a second server process in response to a "redirection" of an initial

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client request. Further details include hashing and the use of tables to correlate location information and identification information.

32. Hudetz disclosed an information collection, transmission, and delivery system effecting universal product code (UPC) to universal resource locators (URL) correlation, translation, resolving, and data correlation effecting information storage, lookup and transfer, including network locational information using multiple resolving servers. See, inter alia, Abstract, Column 7, Lines 1-16, and Column 9, Lines 22-42. The redirection of requests and the transmission of redirection messages/responses was fully provided, inter alia, in Column 9, Lines 54-64. Lastly, the express use of tables, hashing algorithms, and mapping functions in a distributed environment was expressly provided in, inter alia, Column 7, Lines 64-65, and Figure 4. All remaining limitations were either expressly provided by Hudetz, or inherent in the Hudetz system.

33. Claims 1-9 and 12-23 are rejected.

34. Claims 1-9 and 12-23 are rejected under 35 U.S.C. §102(e) as being anticipated by Call (U.S. Patent Number 5,913,210), hereinafter referred to as Call.

35. The claims describe a client generated message which effects a redirection message which is sent to another server process when the initial server process cannot provide a "location string" in response to the client request. Simply, the invention resolves "identification string(s)" into "location string(s)" using a second server process in response to a "redirection" of an initial client request. Further details include hashing and the use of tables to correlate location information and identification information.

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36. Call disclosed a product code translator acting to store, access, lookup, and deliver cross-referenced product code(s) with associated network location information. See, inter alia, Abstract, Column 6, Line 66 through Column 7, Line 6. The implementation of tables holding database records, intrinsically involving hashing/mapping function(s), implemented in a distributed environment was disclosed, inter alia, in Column 5, Line 5 through Column 6, Line 31, Column 7, Lines 7-48, etc., and Figure 2. Redirection of information access/lookup request(s) was expressly envisioned, inter alia, Column 8, Lines 33-65. Additionally, see Column 7, Lines 7-30, where this overly broad characterized functional behavior was also described in yet another type of embodiment, i.e., email. All remaining limitations were either expressly provided by Call, or inherent in the Call disclosure.

37. Claims 1-9 and 12-23 are rejected.

***Response to Arguments***

38. The arguments presented by Applicant in the response, received on 8/25/2004, are not considered persuasive.

39. Applicant argues differing reasons of distinguishing subject matter for each of claims 1, 5 and 12. It is respectfully submitted that each and every one of these independent claims relate to an identical inventive concept, and so, arguments set forth for one should be relevant to each. That is, all the independent claims relate to the same general invention, and so a common thread of distinguishing over the prior art of record must be ascertainable but is not adopted by Applicant in the response received 8/25/2004. In order to properly define the claimed invention over the prior art of record, a common theme of functional limitations found in each of the base

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claims must be identified and discussed. No one set of claims is considered to teach anything above and beyond the other sets of claims.

40. Applicant has failed to modify the claim language to distinguish over the prior art of record by clarifying or substantially narrowing the claim language. Thus, Applicant apparently intends that a broad interpretation be given to the claims and the Examiner has adopted such in the present and previous Office action rejections. See *In re Prater and Wei*, 162 USPQ 541 (CCPA 1969), and MPEP § 2111. Additionally, Applicant employs broad language which includes the use of words and phrases which have broad meanings in the art. In addition, Applicant has not argued any narrower interpretation of the claim language, nor amended the claims significantly enough to construe a narrower meaning to the limitations. As the claims breadth allows multiple interpretations and meanings which are broader than Applicant's disclosure, the Examiner is forced to interpret the claim limitations as broadly as reasonably possible, in determining patentability of the disclosed invention. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The current claims infer coverage breadth which is inconsistent with breadth of the disclosure and are not found distinguishable above the prior art of record.

41. In regard to Applicant's arguments addressed to claims 2-4 and 8, these fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

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42. Lastly, Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

43. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Marc D. Thompson whose telephone number is 571-272-3932. The Examiner can normally be reached on Monday-Friday, 9am-4pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, William Cuchlinski, Jr. can be reached at 571-272-3925. The fax phone number for the organization where this application or proceeding is assigned remains 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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